

REMARKS

Claims 7 and 15-20 are currently pending in the application. Applicant hereby cancels claims 1-6 and 8-14 without prejudice. Claims 15 and 17 are in independent form. Applicant adds new claims 15-20 to clarify the invention. These claims are fully supported by the specification.

Claims 1-7 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, as the claims do not produce a "useful, concrete, tangible result." In response thereto, Applicant has canceled claims 1-7, rendering this rejection moot, and added new independent 15 that further clarifies the invention. The invention produces a concrete result, as it provides for a method of searching for items and vendors of such items. Reconsideration of the rejection is respectfully requested.

Claims 8-14 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, as it is not clear which of the four statutory classes the claims are drawn to. In response thereto, Applicant has canceled claims 8-14, rendering this rejection moot, and included new independent claim 17 to clearly set forth which of the statutory classes the claims are drawn to, i.e. apparatus claims. Reconsideration of the rejection is respectfully requested.

Claims 1-14 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 8-14 are indefinite because the statutory class of the claims cannot be determined. In response thereto, Applicant has added new claims 17-20 to clearly set forth which of the statutory classes the claims are drawn to, i.e. apparatus claims. In claims 1 and 8, the recitation "making available the

identity of the seeker ... before making available the identity of said vendors" is not positively set forth. In response thereto, Applicant has canceled claims 1 and 8, rendering this rejection moot. Further, in new independent claim 17, Applicant has rewritten this phrase for clarification and to positively set forth all recitations. Reconsideration of the rejection is respectfully requested.

Claims 1-3 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,631,372 to Graham in view of U.S. Patent No. 5,664,115 to Fraser. Specifically, the Office Action holds that Graham discloses the claimed method and business application for facilitating the exchange of information between vendors and seekers with the steps of: entering vendors' item records as listings in an electronically searchable data structure and searching the data structure on the basis of seeker queries generated by seekers. Graham also discloses ensuring that the vendor's item records are for items appearing in an electronically searchable item catalogue and ensuring that seeker queries are in respect of items appearing in the item catalogue. Graham fails to disclose commercially sensitive information that the vendor will not make public without knowing the identity of the seeker and making available the identity of the seeker for viewing by the vendors corresponding to matched listings before making available the identity of the vendors for viewing by the seeker. However, Fraser discloses a host system that communicates to anonymous sellers information about an interested buyer to a seller, and a buyer evaluation application to screen potential buyers. Fraser further discloses that upon receiving the prospective buyer's requests, the sellers determined which buyer to respond to based on the information provided by the prospective buyer. Therefore, it would have been obvious to modify the search engine of Graham to include the screening of prospective buyers before matching with anonymous sellers. Reconsideration of the rejection under 35 U.S.C. §103(a), as being unpatentable over the Graham patent, in view of the Fraser patent is respectfully requested.

It is Hornbook Law that before two or more references may be combined to negate patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667 (Fed. Cir. 1985). As stated, the District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art, which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Graham patent relates to search engines used to locate goods and services on the Internet (Col 1, lines 13-15). It addresses the problem of ranking webpages that refer to goods in order to maximize sales of the goods (Col 2, lines 4-10). Figure 2 of Graham depicts a typical search sequence according to one aspect of the Graham invention. The Graham system allows clients, i.e. "seekers," to search for an item (goods and services) on the Internet, a hit list is generated of relevant merchant, i.e. "vendor," websites from which the client can select a hit, the browser navigates to the selected merchant's website at which point the client is made aware of the merchant's identity, and while at the merchant's website, the client can do many things such as "looking around the site at the merchant's offerings, purchasing goods or services, or declining to make a purchase" (col. 3 line 44 – col. 4 line 18). Then, the merchant himself provides data to the search engine regarding the sales association. The identity of the merchant is provided to the client before the identity of the client is provided to the merchant, when the results of the search engine are provided. There is no indication of information being blocked from a client at a merchant's designation, nor is there any suggestion or motivation in Graham to block such information from a client.

The Fraser patent discloses a method and apparatus of matching sellers of property with potential buyers through a communications network. A host system obtains and stores a first set of records corresponding to the property to be sold. The first set of records can be searched by a potential buyer, as shown in Figure 8A. The potential buyer can indicate which properties they are interested in purchasing and provide identifying information to the sellers of the indicated property. Once the request for more information on a particular property is made, the system evaluates the potential buyer to determine if they meet minimum criteria for purchasing the property. The buyer's request for more information along with their evaluation is sent

to the sellers for their review to determine whether to respond to that potential buyer. Thus, the potential buyer is not identified to the seller before they are able to view information regarding property for sale. The evaluation function only comes after the buyer can view information about the items.

In contradistinction, according to the present invention in the new independent claims, the seeker is identified to the buyer before any information is provided regarding an item. A diagram of new independent claim 15 along with dependent claim 16 is provided herein to clarify the process in Exhibit A. A seeker can submit a query to the item catalogue and a search is performed in the listing catalogue. When a seeker executes a search, the seeker's identification is provided to the vendor before any results of the search are returned, therefore assuring that the seeker is authorized to view such items. Furthermore, as in claim 16, the vendor can choose to deny access to their items for a particular seeker, and those items will not show up in any search results of the seeker. The network business application of new independent claim 17 is designed to perform the function of independent claim 15. Neither Graham nor Fraser disclose or suggest identifying the seeker to the vendor before any information about searched items is given out. Neither Figure 2 depicting Graham's process nor Figure 8A depicting Fraser's process disclose the process of the present invention as depicted in Exhibit A.

The Office Action states that Fraser teaches the screening of prospective buyers (i.e. seekers) essentially the same as the present invention. However, the screening process of Fraser only functions to aid sellers (i.e. vendors) in deciding which prospective sale of property might be worthwhile pursuing. It does not block information about a property from ever reaching the buyer when the buyer performs a search. Only after search results are returned to the buyer can the seller gain more information about the buyer and perform the screening function. The present

invention is much different in that the identity of the seeker is provided to the vendor while a search is being performed so that information can be withheld from the search results if the vendor so chooses.

Since neither the cited references alone or in combination with knowledge in the art suggest the currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

Claims 4-7 and 11-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,631,372 to Graham in view of U.S. Patent No. 5,664,115 to Fraser, et al as applied to claims 1 and 8 above, and further in view of U.S. Patent No. 5,758,327 to Gardner, et al. Specifically, the Office Action holds that Graham and Fraser disclose the claimed invention, but fail to disclose granting seekers access to the vendor's records and making available seeker and vendor contact details. However, Gardner, et al. discloses electronic requisition processing with company-specific rules allowing each vendor to nominate seekers who are not to be granted access to the vendor's records, and making available company's and vendor's contact details. Therefore, it would have been obvious to modify the exchange of information of Graham and Fraser to include the teachings of Gardner, et al. Reconsideration of the rejection under 35 U.S.C. §103(a), as being unpatentable over the Graham patent, in view of the Fraser patent, in further view of the Gardner, et al. patent is respectfully requested.

Gardner, et al. provides an electronic requisition system. Requisition rules provide for those individuals in a company that have authorization to place an order with a vendor. Items in the vendor catalogs approved for viewing by companies have

already been approved for each company before viewing online, i.e. the companies have already had contact with the company and viewed all items possible for sale before deciding on those which will be available to them for purchase online. Therefore, the identity of the company does not need to be sent to the vendor for vendor approval of viewable items, as a buyer-seller relationship is already established. As stated above, the Graham patent either alone or in combination with the Fraser patent does not disclose all of the elements of the present invention. Therefore, combination with Gardner, et al. would still not arrive at the present invention.

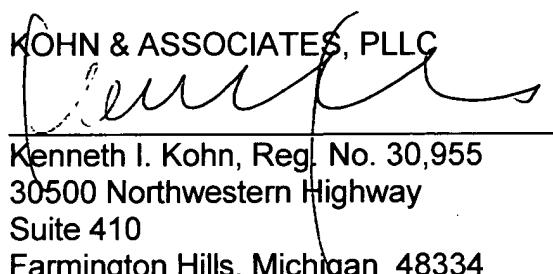
The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above, and the prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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CERTIFICATE OF MAILING

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Connie Herty

Exhibit A

